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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,775	10/02/2003	Stephane Christian Gasparini	CE50061P	9134
20280 7590 01/31/2008 MOTOROLA INC 600 NORTH US HIGHWAY 45 W4 - 39Q LIBERTYVILLE, IL 60048-5343			EXAMINER SAN JUAN, MARTINJERIKO P	
			ART UNIT	PAPER NUMBER
			2132	
			NOTIFICATION DATE	DELIVERY MODE
			01/31/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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ADB035@Motorola.com

## Office Action Summary

Application No.

10/677,775

Applicant(s)

GASPARINI ET AL.

Examiner

Martin Jeriko P. San Juan

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 May 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is a response to Applicant's Remarks filed on November 28, 2007.

Claims 1-21 were originally pending.

Claims 1-21 were rejected on November 20, 2006.

Claim 19 has been cancelled. Claims 1, 2, 11, 12, and 21 have been amended.

Claims 1-18, 20, and 21 were rejected on September 10, 2007.

New claim 22 has been added.

Claims 1-18, and 20-22 are currently pending.

### ***Response to Arguments***

1. Applicant's arguments filed on November 28, 2007 have been fully considered but they are not persuasive.

Applicant respectfully submits that Manduley does not anticipate, either expressly or inherently, as set forth in claim 12, specifically the limitation reciting "forming a feature change code from the authorization key and information related to an authorized feature set." Traversal of the other claim rejections by the Applicant is based on the above argument.

The Examiner respectfully disagrees. In the previous Office Action dated September 10, 2007, the Examiner cited US 5956505, Col 8, Ln 29-35 to read on both the Authorization Key and the Feature Change Code of the Applicant. The Examiner stated that the code (generated by the Data Center of Manduley) is both the Authorization key, and the Feature Change Code since this code authorizes the change (being a valid code), and has data that implements the feature changes. To explain clearly and citing from the above passage, Mandulay discloses: "...the data center generates a code that when entered into device will cause device to update its activation map to activate the requested application or features." Furthermore, the Activation Code of Mandulay "includes data necessary to cause the activation map to reflect an amount usage limitation or deadline in the case of features for which temporary activation is requested." Mandulay discloses properties of the Authorization Key of the Applicant. The Applicant's Authorization Key has the property of providing authorization for feature release to cause the software to be enabled and access to be granted to the feature changes [Specification, Pg 6, Ln 15-17]. Thus, Mandulay anticipates the Applicant's Authorization Key inherently in Mandulay's Activation Code. Also note from the above passage that Mandulay teaches his Activation code to contain information related to an authorized feature set. The Applicant's claim limitation "forming a feature change code from the authorization key and information related to an authorized feature set" clearly implies that the Authorization Key is made inherent with the Feature Change Code. The claim limitations are inline with Mandulay's invention.

The Examiner is maintaining his previous rejection.

Regarding new claim 22, the subject matter claimed is still taught in the above cited passage of Manduley [US 5956505, Col 8, Ln 29-35]. Refer to the Prior Art Rejection Section under 35 USC 103(a) for claim 22.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 12, 15, 16, and 20 are rejected under 35 U.S.C. 102(b) as being unpatentable over Manduley [US Pat No. 5,956,505].

With regard to claim 12, Manduley discloses a method of authorizing change in the available features in a software-implemented feature set containing a plurality of features (Abstract), comprising the steps:

receiving a token (Col. 7, lines 53-54, Fig. 4-A, step 206 - discloses a request code entered by the user and input into the data center which reads on token);

obtaining identification information and feature related information from the token (Col. 7, lines 62-65, Fig. 4-A, step 208 – discloses obtaining what program or features are requested and information identifying the device – which reads on identification information and feature related information);

in response to a determination to authorize change in the feature set, the further steps of:

Using the identification information to generate an authorization key [Col 8, Ln 29-33 – The data center generates a code (reading on authorization key) when entered into device will cause device to update its activation map to activate the requested application or features.];

forming a feature change code from the authorization key and information related to the authorized feature set [Col 8, Ln 29-35 – The authorization key and feature change code is an integrated code.]; and

issuing the feature change code (Col. 8, lines 29-32 – discloses generating a code that will cause updating of activation map of the device to activate the requested features).

With regard to claim 15, Manduley discloses the identification information comprises data relating to at least one of a software identification number; a Device identification number; a Subscriber identification number (Col. 4, lines 43-47).

With regard to claim 16, Manduley teaches the method as claimed in claim 12, wherein the identification information also comprises hardware version number data or software version number data [Col 5, Ln 20-25 – Configuration record is evidence for hardware and software version data; note determination of whether “stand-alone system” and any necessary hardware.].

With regard to claim 20, Manduley discloses the token contains payment information in respect to the requested feature alteration (Col. 8, lines 24-28).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manduley [US PN 5956505] and further in view of Barrus et al. [US 2003/0204721 A1].

With regard to claim 17, the invention of Manduley teaches the method as claimed in claim 12, where the step of obtaining information from the token comprises the step of deriving encrypted data from the received token [US PN 5956505, Col 6, Ln 49-50].

Manduley does not explicitly teach where the step of obtaining information from the token comprises deriving a secret key and using the secret key as a decryption key to decrypt the encrypted data to obtain feature related information.

Barrus et al. teaches the method of obtaining information from a token that comprises deriving a cryptographic key used to decrypt encrypted data [US 2003/0204721 A1, Pg 2, Par 0022].

It would have been obvious to one of ordinary skill in the art at the time of invention to be able to derive a secret cryptographic key as taught by Barrus et al. from the token of Manduley, and be able to use the derived secret key to decrypt the encrypted data also derived from the token. The suggestion/motivation for combining would have been to cryptographically secure the token request that would also be unique and specific to the request. This prevents the use of obtained token request information to other token



requests, thereby increasing security. Barrus et al. and Manduley are analogous art because they solve the problem by adding another security layer.

With regard to claim 18, the invention of Manduley teaches the method as claimed in claim 12, where the step of generating an authorization key comprises the step of using the identification data.

Manduley does not teach where the step of generating an authorization key also comprises forming a secret key from the identification data.

Barrus et al. teaches the method of deriving a secret key from an identification data of a token [US 2003/0204721 A1, Pg 2, Par 0021-0022 --The token (from which keys can be derived) can be any identifier data.].

It would have been obvious to one of ordinary skilled in the art at the time of invention to be able to derive a secret cryptographic key as taught by Barrus et al. from the identification data contained in the token of Manduley, and be able to use the derived secret key to decrypt encrypted data that can also be derived from the token. The suggestion/motivation for combining would have been to cryptographically secure the token request that would also be unique and specific to the request. This prevents the use of obtained token request information to other token requests, thereby increasing security. Barrus et al. and Manduley are analogous art because they solve the problem by adding another security layer.

2. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manduley [US PN 5956505] and further in view of Parfenov et al. [US 2002/0138728 A1].

With regard to claim 13, the invention of Manduley teaches the method as claimed in claim 12, but Manduley does not teach wherein a random number is also obtained from the received token.

Parfenov et al. teaches wherein a random number is also obtained from the received token [US 2002/0138728 A1, Pg 3, Par 0030 – The second message contains the same random number that was sent in the first message.]

It would have been obvious to one of ordinary skill in the art at the time of invention to include a random number in a request token. The suggestion/motivation would have been to add another layer of security for preventing a “replay attack” because a random number generated is specific to the time the request and authorization is made.

Manduley and Parfenov et al. are analogous art because they solve the problem of a “replay attack.”

With regard to claim 14, the invention of Manduley teaches the method as claimed in claim 13, but Manduley does not teach wherein the random number is used in the step of generating the authorization key.

Parfenov et al. teaches wherein the random number is used in the step of responding back from an initial message or request. [US 2002/0138728 A1, Pg 3, Par 0030 – The

second message contains the same random number that was sent in the first message.]

It would have been obvious to one of ordinary skill in the art at the time of invention to use the random number in the step of responding back from the request token which in Manduley's invention comprise of generating the authorization key. The suggestion/motivation would have been to add another layer of security for preventing a "replay attack" because a random number generated is specific to the time the request and authorization is made. Manduley and Parfenov et al. are analogous art because they solve the problem of a "replay attack."

3. Claims 1-2, 5-6, 9-11, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manduley [US PN 5956505] and further in view of Leovac [US PN 6668375 B1].

With regard to claim 1, Manduley teaches a method of changing the available features in a software- implemented feature set containing a plurality of features, comprising the steps: forming a token from identification information and feature related information [US PN 5956505, Col 6, Ln 46-48] and issuing the token from a communication device [US PN 5956505, Col 7, Ln 57-60]; receiving the token at an authorization device and obtaining identification information and desired feature related information from the token [US PN 5956505, Col 7, Ln 57-60]; in response to a determination to authorize change in the feature set, the further steps of: using the identification information to

generate an authorization key [US PN 5956505, Col 6, Ln 22-24 – discloses generating a code (containing ID information) that represents the application or features or both for which activation is requested, --This is evidence of a pending authorization key because this data is used for the determination of generating an authorization key.] [US PN 5956505, Col 8, Ln 29-33 – The data center generates a code (reading specifically on authorization key) when entered into device will cause device to update its activation map to activate the requested application or features.]; forming a feature change code from the authorization key and information related to an authorized feature set and issuing the feature change code from the authorization device [US PN 5956505, Col 8, Ln 29-35 – The authorization key and feature change code is an integrated code.]; and receiving the feature change code at the communication device and obtaining the authorization key and information related to the authorized feature set from the feature change code [US PN 5956505, Col 8, Ln 29-35 – The authorization key and feature change code is an integrated code.]; and implementing the authorized feature set if the authorization key integrated feature change code is valid [US PN 5956505, Col 8, Ln 29-35].

Manduley does not teach generating a local authorization key using the identification information; comparing the authorization key obtained from the feature change code [Authorization key is integrated with the feature change code.] with the local authorization key; and implementing the authorized feature set if the authorization key obtained from the feature change code and the local authorization key match.

On the other hand Leovac teaches a method of changing the available features in a software-implemented feature set containing a plurality of features [US PN 6668375 B1, Col 1, Ln 6-10] comprising generating a local authorization key using the identification information [US PN 6668375 B1, Col 3, Ln 53-58]; comparing the authorization key obtained from the feature change code with the local authorization key [US PN 6668375 B1, Col 3, Ln 58-60. Authorization key is integrated with the feature change code. Note Figure 2, ie "key + exclusions" data.]; and implementing the authorized feature set if the authorization key obtained from the feature change code and the local authorization key match [US PN 6668375 B1, Col 3, Ln 60-65.].

It would have been obvious to one of ordinary skill in the art at the time of invention to extend the generation and use of the authorization key as taught by Leovac into Manduley's invention. The suggestion/motivation for further extending the generation and use of such an authorization key would be to add a layer of security by ensuring that such authorized changes is specific to the feature change request [US 6668375 B1, Col 1, Ln 35-37], and that the feature change code comes from a trusted entity [Only a trusted entity would know the hash/digest function used to generate the authorization key.]. Manduley and Leovac are both analogous art because they are both in the same field of endeavor pertaining to providing new options to already installed software.

With regard to claim 2, the combined invention of Manduley and Leovac teaches a method of a communication device for changing the available features in a software-implemented feature set containing a plurality of features, comprising the steps: forming a token from identification information and feature related information [US PN 5956505, Col 6, Ln 46-48] and issuing the token to an authorization device [US PN 5956505, Col 7, Ln 57-60]; receiving a feature change code from the authorization device and obtaining an authorization key and information related to an authorized feature set from the feature change code [US PN 5956505, Col 7, Ln 57-60]; generating a local authorization key using the identification information [US PN 6668375 B1, Col 3, Ln 53-58]; comparing the received authorization key obtained from the feature change code with the local authorization key [US PN 6668375 B1, Col 3, Ln 58-60]; and implementing the authorized feature set if the received authorization key obtained from the feature change code and the local authorization key match [US PN 6668375 B1, Col 3, Ln 60-65].

With regard to claim 5, the combined invention of Manduley and Leovac teach the method as claimed in claim 1, wherein the identification information comprises data relating to at least one of a software identification number; a Device Identification number; a Subscriber Identification Number [US PN 5956505, Col. 4, lines 43-47].

With regard to claim 6, the combined invention of Manduley and Leovac teach the method as claimed in claim 5, wherein the identification information also comprises

hardware version number data or software version number data [US PN 5956505, Col 5, Ln 20-25 – Configuration record is evidence for hardware and software version data; note determination of whether “stand-alone system” and any necessary hardware.].

With regard to claim 9, the combined invention of Manduley and Leovac teach the method as claimed in claim 1, where the step of generating a local authorization key uses a non-reversible operation [A digest/hash function is a non-reversible operation.].

With regard to claim 10, the combined invention of Manduley and Leovac teach the method as claimed in claim 1, where the token contains payment information in respect of the requested feature alteration [US PN 5956505, Col 8, Ln 24-28].

Regarding claim 22, the combined invention of Manduley and Leovac teach the method as claimed in claim 1, wherein the feature-change code enables alteration of the software-implemented feature set on a feature-by-feature basis [US 5956505, Col 8, Ln 29-35 --Examiner notes feature-change code updates Activation Map.] [US 5956505, Col 5, Ln 21-25 --Examiner notes implementation of Activation Map enables alteration of feature set on a feature-by-feature basis.].

Claims 11 and 21 are rejected because it is the apparatus performing the method of claims 2 and 1 respectively.

4. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manduley [US PN 5956505] and further in view of Leovac [US PN 6668375 B1] and Barrus et al. [US 2003/0204721 A1].

Claim 7 and 8 are rejected because it is the same subject matter as claim 17 and 18 respectively.

5. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manduley [US PN 5956505] and further in view of Leovac [US PN 6668375 B1] and Parfenov et al. [US 2002/0138728 A1].

Claims 3 and 4 are rejected because it is the same subject matter as claim 13 and 14 respectively.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

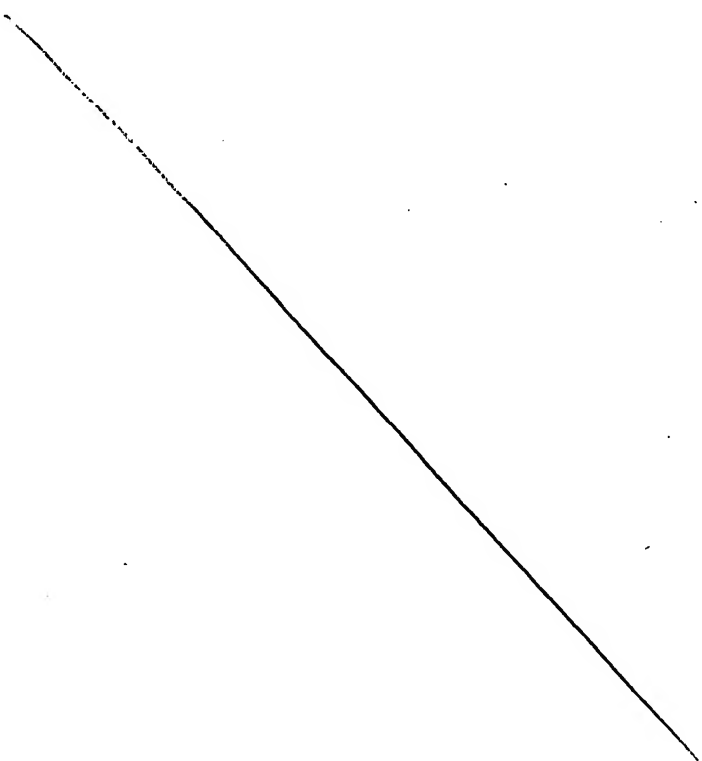
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not



mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Jeriko P. San Juan whose telephone number is 571-272-7875. The examiner can normally be reached on M-F 8:30a - 6:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Application/Control Number:  
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Art Unit: 2132

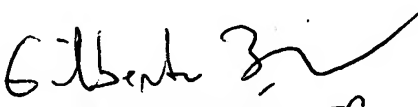
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/MJSJ/

Martin Jeriko San Juan

Examiner. Art Unit 2132

  
GILBERTO BARRON JR  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100